

REMARKS

Reconsideration of this application is respectfully requested. Claims 13 and 14 have been canceled without prejudice. Claims 1-12 and 15-31 are pending and at issue.

Obviousness Rejection

Claim 1 has been rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent Publication No. 2003/0232085 (“the ‘085 Application”).

Applicants respectfully traverse this rejection and request reconsideration.

Claim 1 of the present application is entitled to the filing date of U.S. Provisional Application No. 60/171,213, filed December 16, 1999. The ‘085 Application was published more than three years after the effective filing date of the present application. Accordingly, the ‘085 Application only qualifies as a prior art reference under 35 U.S.C. §102(e).

Submitted herewith is a Declaration pursuant to 35 U.S.C. §103(c). The Declaration states that the ‘085 Application and the present application were, at the time the invention claimed in the present application was made, owned by the same assignee (Emisphere Technologies, Inc.) or subject to an obligation of assignment to the same assignee. Pursuant to 35 U.S.C. § 103(c), the ‘085 Application is not a prior art reference under 35 U.S.C. §103(a). Accordingly, applicants respectfully request withdrawal of this rejection.

Rejoinder of Claims

Applicants respectfully request that claims 2-12 and 15-31 be rejoined with claim 1 in this application. Claims 2-12 and 15-31 depend from claim 1. Accordingly, if claim 1 is patentable

over the prior art, so too are claims 2-12 and 15-31. Therefore, examination of all of the pending claims in this application would not be a serious burden. *See* M.P.E.P. §803.

Furthermore, M.P.E.P. §821.04 provides that "if [an] applicant elects claims directed to [a] product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Similarly, method and product claims 2-12 and 15-31 depend from allowable claim 1 and therefore should be rejoined.

In view of the above arguments, the pending claims in this application are believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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